

MAR 05 2007

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

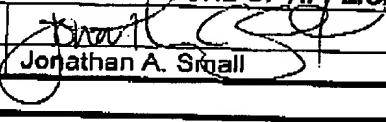
TRANSMITTAL FORM

		Application Number	09/558,925
		Filing Date	04/26/2000
		First named inventor	KEMBEL et al.
		Examiner Name	J. E. Avellino
		Confirmation Number	1658
		Art Unit	2143
Total number of pages in this submission	41	Attorney Docket No.	D/10351-007

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/Declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawings <input type="checkbox"/> License-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of disks <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal to TC - Appeal Brief, Request for Oral Hearing <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> PTO-2038 Credit Card Authorization Form <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks:		

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT REQUIRED

Signature: 	Telephone: 650-941-4470
Name: Jonathan A. Small	Registration no. 32, 631
	Date: March 5, 2007

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Signature: 	Telephone: 650-941-4470
Name: Jonathan A. Small	Registration no. 32, 631
	Date: March 5, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/17 (12-04v2)

OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Complete if known

FEET TRANSMITTAL		Application Number	09/558,925
		Filing Date	04/26/2000
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		First named inventor	KEMBEL et al.
		Examiner Name	J. E. Avellino
		Art Unit	2143
TOTAL AMOUNT OF PAYMENT (\$ 750.00)		Attorney Docket No.	D/10351-007

METHOD OF PAYMENT (check all that apply)

Check Credit Card (Form PTO-2038 enclosed) Other (please identify): _____

Deposit Account Number: _____ Account name: _____

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below Credit any overpayments

Charge any additional fee(s) or underpayment of fee(s) under 37 C.F.R. 1.16 and 1.17

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Fee Calculation**1. Basic Filing, Search, and Examination Fees**

Application Type	Filing Fee		Search Fee		Examination Fee		Fees Paid (\$)
	Fee (\$)	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Small Entity	
Utility	300	150	500	250	200	100	00.00
Design	200	100	100	50	130	65	00.00
Plant	200	100	300	150	160	80	00.00
RCE	790	395					00.00
Provisional	200	100					00.00

2. EXCESS CLAIM FEES

Each claim over 20 (including Reissues)	Fee (\$)	Small Entity Fee (\$)
	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
- 20 =	-	x	=	Fee (\$)
- 3 =	-	x	=	Fee Paid (\$)

3. APPLICATION SIZE FEE

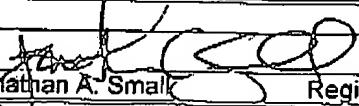
If the specification and drawings exceed 100 sheets, the application size fee is \$250 (\$125 for small entity) for each additional 50 sheets or fractions thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s)

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100	/50		x	= \$00.00

4. OTHER FEE(S)

Filing of Appeal Brief	Fee Paid \$250.00
Request for Oral Hearing on Appeal	Fee Paid \$500.00

SUBMITTED BY

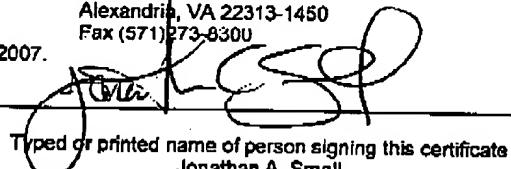
Signature: 	Telephone: 650-941-4470
Name: Jonathan A. Smalk	Registration no. 32,631 Date: March 5, 2007

RECEIVED
CENTRAL FAX CENTER
MAR 05 2007

PATENT APPLICATION
Attorney Docket No. D/10351-007

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this correspondence is being transmitted by facsimile to:
United States Patent and Trademark Office
Commissioner for Patents
Alexandria, VA 22313-1450
Fax (571) 273-8300

on March 5, 2007.


Typed or printed name of person signing this certificate
Jonathan A. Small

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: KEMBEL et al.)	Confirmation No.: 1658
Appl. No.: 09/558,925)	Art Unit: 2143
Filed: 04/26/2000)	Examiner: J. E. Avellino

Title: Apparatus and Method for Interacting with Internet Content

United States Patent and Trademark Office
Commissioner for Patents
Washington, D.C. 20231

APPEAL BRIEF

Sir:

Applicant respectfully submits this Appeal Brief in the appeal from the Office Action dated September 11, 2006, (hereinafter referred to as the "Office Action") in which all claims were finally rejected. Applicant filed its Notice of Appeal on January 5, 2007.

03/06/2007 TL0111 00000007 09558925

02 FC:2402

250.00 0P

page 1

MAR 05 2007

Appl. No. 09/558,925

Table of Contents

Table of Contents	2
1. Real Party in Interest	3
2. Related Appeals and Interferences	4
3. Status of the Claims	5
4. Status of Amendments	6
5. Summary of Claimed Subject Matter	7
6. Grounds of Rejection to be Reviewed on Appeal	9
7. Argument	10
A. <i>Are claims 70-75 non-statutory under 35 U.S.C. 101 for failing to produce a "useful, concrete, and tangible result"?</i>	10
B. <i>Do claims 70-75 claim data per se, and are they therefore not statutory under 35 U.S.C. 101?</i>	12
C. <i>Are claims 31-41, 50, 52-55, and 60-77 unpatentable under 35 U.S.C. 103(a) in view of Furst (U.S. patent 6,297,819)?</i>	14
(1) <i>Where: Furst fails to teach or suggest a tool window rendered such that it is "not confined by a window of a Web browser program", nor "wherein the visual manifestation of Internet content is rendered separate from a window of a Web browser program"</i>	16
(2) <i>How: Furst fails to teach or suggest "the frame and first Internet content rendered independently from a Web browser program"</i>	20
9. Summary and Conclusion	26
APPENDIX 1 –Appealed Claims	i
APPENDIX 2 – Evidence of Record	x
APPENDIX 3 – Related Proceedings	xi

RECEIVED PAGE 07/41
CENTRAL FAX CENTER

MAR 05 2007

Appl. No. 09/558,925

1. Real Party in Interest

The real party in interest is Mainstream Scientific, LLC, the assignee of all right and interest in and to the present application and any patent issuing thereon.

**RECEIVED
CENTRAL FAX CENTER**

MAR 05 2007

Appl. No. 09/558,925

2. Related Appeals and Interferences

As of the date hereof, there are no related appeals nor interferences.

RECEIVED
CENTRAL FAX CENTER

MAR 05 2007

Appl. No. 09/550,925

3. Status of the Claims

Claims 31-41, 50, 52-55, and 60-77 are pending in the present application.

Claims 31-41, 50, 52-55, and 60-77 (all) were finally rejected in the Office Action.

Claims 31-41, 50, 52-55, and 60-77 (all) are appealed.

RECEIVED
CENTRAL FAX CENTER

MAR 05 2007

Appl. No. 09/558,925

4. Status of Amendments

No amendment after Final Rejection has been submitted. All amendments have been entered.

MAR 05 2007

Appl. No. 09/558,925

5. Summary of Claimed Subject Matter

The present invention is directed to a method of rendering internet content in a unique frame (referred to in the application as a NIM), for example on a user's display. The frame has a format, and includes controls, which are designed to relate to the content as determined by the frame provider (i.e., specific to the content). While the content is capable of being read by an internet browser application, both the frame and the content are actually rendered independent of a web browser application as well as entirely outside of a web browser window.

The Independent claims of the present application fall into two categories. The first category is directed to a method for presenting internet content to a user of a computer device (claims 31, 50, and 62). The method essentially involves obtaining content that is readable by a web browser, and rendering same in a frame and with controls, such that it is rendered both (i) independent from a web browser program and (ii) outside of a web browser window. The second category is directed to a computer readable storage medium having stored thereon software for displaying and interacting with internet content independent of a web browser program (claims 70, 76). The software includes data and methods by which the data is rendered independent from a web browser program (claim 70) and further such that it is rendered separate from the window of a web browser program (claim 76).

Appl. No. 09/558,925

In terms of the specification, these limitations are illustrated for example at page 20, line 18, which states that "... the content of the NIM is not trapped in a third party viewer." That is, the content need not be rendered within or tied in any way to a web browser window. (See also, for example, Figs. 9A and 9B which illustrate a number of NIMs, showing them completely outside of and disconnected from any sort of web browser application window.)

Perhaps more to the heart of the issue in this appeal is where the specification discusses the ability to render a NIM without reliance on a web browser program. At page 33, lines 17-18, the specification states that "[t]he definition of a NIM thus includes everything that is needed for the NIM to be rendered and filled with Internet content." That is, nothing from or associated with a web browser application is needed in order to render the content of a NIM in its window.

The motivation to develop components capable of rendering internet content without dependence on a web browser is at least two-fold. First, this independence from a web browser application frees the content provider from the constraints on presentation of content imposed by traditional web browser software and browser user interfaces, such as rectangular windows, limited controls, etc. Second, the independence from a web browser program means that components may be rendered using fewer computing resources, on a greater variety of platforms, and may operate without requiring the presence of any particular vendor's web browser application, indeed without requiring the presence of any web browser application at all.

Appl. No 09/558,925

6. Grounds of Rejection to be Reviewed on Appeal

Tracking the final rejection of the claims in the Office Action, the issues in this appeal are:

- A. Are claims 70-75 non-statutory under 35 U.S.C. 101 for failing to produce a "useful, concrete, and tangible result"?
- B. Do claims 70-75 claim data per se, and are therefore not statutory under 35 U.S.C. 101?
- C. Are claims 31-41, 50, 52-55, and 60-77 unpatentable under 35 U.S.C. 103(a) in view of Furst (U.S. patent 6,297,819)?

Each of these issues are addressed in order in the Argument section, following.

MAR 05 2007

Appl. No. 09/558,925

7. Argument

A. *Are claims 70-75 non-statutory under 35 U.S.C. 101 for failing to produce a “useful, concrete, and tangible result”?*

Initially, applicant points out that claim 70 recites, in part “A computer-readable storage medium having stored thereon a software object for displaying and interacting with content data in a frame independent of a Web browser program, comprising...” (claim 70, lines 1-3). Thus, claim 70 is limited to a storage medium – a thing, as opposed to a process for performing some action. (Likewise, claims 71-75 are limited to “A computer-readable storage medium...” by way of their dependence on claim 70.) The Office Action ignores the fact that the very terms of the claim limit it to a storage medium. However, it is well recognized that ignoring such a limitation is improper. Each element or step of a claim forms a facet of the overall claim, and it is this overall claim that must be judged against wording and interpretations of 35 U.S.C. §101. For example, “In determining the eligibility of [a claim] for patent protection under §101, the claims must be considered as a whole.” Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981). See also the PTO’s own “Examination Guidelines for Computer-Related Inventions” which state that any claim analysis must include “identifying and evaluating each claim limitation” (Part II, C).

Appl. No. 09/558,925

By its limitation to a computer readable storage medium, claim 70 (and claims 71 – 75 which depend from claim 70) falls within the statutory category under 35 U.S.C. §101 of article of manufacture. As an article of manufacture, the claimed subject matter does not produce a result – again, it is a "thing" as opposed to a process. Historically, the language "useful, concrete, and tangible result" has been associated with process claims. (See, e.g., Diamond v. Diehr, *supra*.) But, since claim 70 et seq. are not process claims, their rejection as not providing a "useful, concrete, and tangible result" is a non sequitur. It is the structural language of claim 70 cited above which renders the process-centered rejection improper. Applicant therefore argues that claims 70-75 are within a statutory class under 35 U.S.C. §101.

The rejection of claims 70-75 under 35 U.S.C. §101 as not providing a "useful, concrete, and tangible result" has previously been unsuccessfully traversed by applicant on the aforementioned grounds. Accordingly, applicant argues here on appeal that the rejection of claims 70-75 under 35 U.S.C. §101 as not providing a "useful, concrete, and tangible result" be reversed.

Appl. No. 09/558,925

B. *Do claims 70-75 claim data per se, and are they therefore not statutory under 35 U.S.C. 101?*

As pointed out above, claims 70-75 are directed to a "computer-readable storage medium" having stored thereon a number of functional software objects and not, as asserted in the Office Action, directed merely to data per se. Again we find the limitation of "A computer-readable storage medium" in the claims (e.g., claim 70, line 1), which cannot be ignored. Diamond v. Diehr, *supra*.

Claim 70 (and claims 71-75 which depend from claim 70) is directed to a computer-readable storage medium having certain data stored thereon. As such, the claim is directed to "functional descriptive material" (as defined by MPEP 2106) recorded on a computer-readable medium. As stated in MPEP 2106, "[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." Thus, pursuant to the direction provided by the MPEP, claims 70-75 satisfy the requirements of 35 U.S.C. 101, and on this ground applicant has traversed the rejection of claims 70-75.

Applicant asserts that under the PTO's own interpretation of the law governing statutory subject matter, the computer-readable medium having functionally descriptive material recorded thereon of claims 70-75 do, in fact, satisfy the requirements of

Appl. No. 09/558,925

statutory subject matter under 35 U.S.C. §101. The rejection of claims 70-75 under 35 U.S.C. §101 as being directed to data per se has previously and unsuccessfully been traversed by applicant on the aforementioned grounds. Accordingly, applicant argues here on appeal that the rejection of claims 70-75 under 35 U.S.C. §101 be reversed.

Appl. No. 09/558,926

C. Are claims 31-41, 50, 52-55, and 60-77 unpatentable under 35 U.S.C. 103(a) in view of Furst (U.S. patent 6,297,819)?

Claims 31-41, 50, 52-55, and 60-77 stand rejected as being unpatentable under 35 U.S.C. 103(a) in view of Furst (U.S. patent 6,297,819). All limitations of these claims are asserted to be shown by Furst, with the exception of explicitly stating that the frame and internet content are rendered independently of a web browser program. As to this point, the Office Action states that

Furst does disclose that the [tool windows] can take other forms, such as free-form graphics without enclosing boxes or window decorations and that the tool windows are updated by the tools with the information generated by the application programs... This would indicate to one of ordinary skill in the art that the tool is independent of the browser window. (Office Action, page 3, lines 13-16).

Applicant makes the following two points in arguing that Furst fails to disclose or suggest each and every limitation of the invention claimed in the present application:

- (1) Furst fails to teach or suggest a tool window rendered such that it is "not confined by a window of a Web browser program", nor similarly "wherein the visual manifestation of ... Internet content is rendered separate from a window of a Web browser program", and

Appl. No. 09/558,925

(2) Furst fails to teach or suggest "the frame and first Internet content rendered independently from a Web browser program".

Each of these points is discussed in further detail following a brief summary of the Furst disclosure, below.

The gist of the Furst reference is a system allowing services, such as program applications (referred to as tools), located on a computer other than a user's computer to run on a user's computer. This is accomplished by running a system program (called a client) on the user's computer which "interacts with the user's running web browser" (Furst, col. 2, lines 16-17) and servers on which the tools are located. In the language of Furst, this is explained as a system providing "World Wide Web browser extensions based on server processes rather than on plug-in program modules loaded and installed on a user's machine." (Furst, abstract, lines 3-5.) A user's interface to the tools are by way of windows of the type shown at 402 and 404 in Fig. 4A, or alternatively as other objects such as icons 502, 504, 506 shown in Fig. 5 "displayed by a web browser operating as a program embedded in the client." (Furst, col. 2, lines 29-30).

One key aspect of Furst is that it is "a browser-aware application delivery system." (Furst, col. 1, lines, 56-57.) That is, it is designed to augment the use of a browser application in surfing the web. The client (the system taught by Furst) is essentially a shell in which a browser program is running. (Furst, col. 4, lines 63-65.)

Appl. No. 09/558,925

Remote tools may be accessed by the client via the browser application, which also generates the interface to those tools. Thus, the presence of the embedded browser program is critical. It provides both access to the application programs and the interface for those programs.

With this summary in mind, the two main points of applicant's argument are next addressed.

(1) *Where: Furst fails to teach or suggest a tool window rendered such that it is "not confined by a window of a Web browser program", nor "wherein the visual manifestation of ... Internet content is rendered separate from a window of a Web browser program"*

Fundamentally, applicant's disagreement that Furst renders the present invention obvious has to do with *where* windows are rendered, and *how* they are rendered. This first part of applicant's argument relates to the where, and the second part of the argument relates to the how.

Claim 31 of the present application recites in part "wherein the visual manifestation of the first Internet content is not confined by a window of a Web browser program" (claim 31, lines 8-10). (That is, applicant focuses here on *where* the visual manifestation of the first internet content is rendered.) See also this limitation at independent claim 50, lines 8-9, and independent claim 62, lines 10-11.

Appl. No. 09/550,925

The Office action cites col. 7, lines 44-50, col. 8, lines 39-46, and Fig. 5 of the Furst reference in support of the assertion that that reference teaches rendering Internet content such that a "visual manifestation of the internet content is not confined by a window of a Web browser program." However, a careful reading of the cited sections and a review of the cited figure show that this is not what these sections of Furst disclose. The cited text at col. 7 relates to methods for a third party to register a new tool with the system disclosed by Furst. A third party tool which provides certain details via a registration page may then operate within the client. Nothing is discussed or suggested at this section of Furst about rendering the tool outside of the window of a browser program.

The cited text at col. 8 relates to the shape of and decorations found within a tool window. The section merely suggests that such tool windows may be free-form shaped and may be rendered without decorations. Free form shapes may be rendered with, and in fact may be windows of, a web browser application. And it was well known at the time of applicant's invention that web browser windows could be rendered without decorations. As applicant will demonstrate below, the invention disclosed by Furst is expressly dependent upon the presence of a browser application for the rendering of tool windows. By its own description, Furst requires the use of a web browser application (associated with other software) to render tool windows. It must therefore be true that any window rendered by Furst is a browser application window unless specifically stated otherwise. Yet, there is nothing disclosed in this section or elsewhere

Appl. No. 09/558,925

in Furst teaching the rendering of a tool window such that it is not confined by the window of a browser program.

Finally, as to Fig. 5, that figure shows tool icons rendered as "tabs" connected to and extending without and within a web browser window. This rendering of the tabs connected to and partially within the browser window is quite the opposite of rendering the tool such that it is "not confined by a window of a Web browser program", as well as "wherein the visual manifestation of ... Internet content is rendered separate from a window of a Web browser program". There is no text in Furst relating to Fig. 5 identified in the Office Action which states that the tabs might be rendered fully separate from or outside of (i.e., not confined by) the frame of the web browser window. To the contrary, it is stated that the tools are shown to "span the scroll bar of the current web browser window" (column 8, lines 45-46).

Therefore, applicant asserts that Furst is silent about actually rendering tools such that they are not confined by or are separate from a window of a web browser program. Indeed, the only examples of tools provided by Furst are described or shown attached to and at least partially within a web browser window or are web browser windows themselves.

By rejecting applicant's claims under 35 U.S.C. 103(a), the Examiner implicitly proposes to modify the disclosure of Furst so as to demonstrate the present invention (*cp.*, a rejection under 35 U.S.C. 102). However, applicant further asserts that Furst

Appl. No. 09/558,925

makes no suggestion of modifying its own teachings in order to obtain the rendering of tools such that they are not confined by or separate from a window of a web browser program. Any modification of a reference proposed by the patent office must be explicit and must be supported by some suggestion or motivation identified by the office to make that modification so as to render obvious the claimed invention. Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990). However, no specific suggestion or motivation to render tools such that they are not confined by or are separate from a window of a web browser program has been identified in the Office Action. And, applicant asserts that indeed there is no such suggestion or motivation in the reference.

The limitation "the visual manifestation of the first Internet content is not confined by a window of a Web browser program" is found in claim 31, lines 8-10, and by their dependence on claim 31, is also found in claims 32-41. The limitation "wherein the [content window] is not confined by a window of a Web browser program" is found in claim 50, lines 8-9, and by their dependence on claim 50, is also found in claims 52-55 and 60-61. The limitation "wherein the visual manifestation of the content data and the user interface is not confined by a window of a Web browser program" is found in claim 62, lines 10-11, and by their dependence on claim 62, is also found in claims 63-69. Since applicant has demonstrated that these limitations are not disclosed nor suggested by the cited reference, and hence no prima facie case of obviousness made under 35 U.S.C. §103(a), applicant argues that these claims are therefore patentably distinct from Furst and therefore should be allowed. Therefore, reversal of the final rejection of

Appl. No. 09/558,925

claims 31-77 under 35 U.S.C. §103(a) and an indication of allowability is respectfully requested.

(2) *How: Furst fails to teach or suggest "the frame and first Internet content rendered independently from a Web browser program".*

In addition to the difference between Furst and the claimed invention based on **where** the windows are rendered, Furst and the claimed invention differ on **how** the windows are rendered. Furst is unquestionably clear that an internet browser program forms an integral part of his invention. There are many portions of the Furst disclosure which make this clear.

For example, the following sections are representative of the various references to the dependence of the client (Furst's system) on the user's web browser application:

- In the Abstract (at line 2-3) "a browser-aware application delivery system"
- In the Summary (at col. 1, lines 20-21) "receives information about what the user is doing on the web from the user's web browser"; (at col. 2, line 29) "displayed by a web browser operating as a program embedded in the client"

Appl. No. 09/558,925

- In the Detailed Description (at col. 4, lines 63-65) "The client 124 is essentially a thin shell for an embedded web browser, whose function is to display web pages sent by the System or by component application tools"; (at col. 5 lines 18-20) "when the user launches the web browser 122, the web browser causes the client 122 (sic) to be launched automatically"; and indeed (at col. 8, lines 16-17, emphasis added) the very sentence cited against the claims and referred to above begins "[a]s the user navigates the web using the web browser and the context changes..."
- In Fig. 4A in which the internet Explorer icon is shown in the upper right corner of the tool window 402, and Fig. 5 in which the tool icons are shown connected to and extending both without and within a traditional Internet Explorer browser window.

The pervasive dependence by the system of Furst on an internet browser application cannot be selectively ignored in the process of rejecting applicants claims. Diamond v. Diehr, supra. And if the Examiner seeks to show that the claimed invention is taught by ignoring certain elements of the cited reference (i.e., modifying the cited reference), the Examiner must identify, either in the reference or in the general knowledge in the art, and without reference to the claimed invention, demonstrable evidence for a suggestion to ignore those specific elements. "[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements

Appl. No. 09/558,925

from the cited prior art references ... in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). This burden falls squarely on the Examiner in the first instance. Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990). Absent such a suggestion, all of the teachings of the reference must be considered as a whole, each integral to the operation of the teachings of the reference. No suggestion or motivation to separate tools from web browser has been identified in the rejection of claims 31-77, and applicant asserts that there is no such suggestion or motivation in Furst.

The Examiner points to col. 8, lines 20-38 to suggest that the system of Furst is not dependent on a web browser application, stating that "the 'client browser' of Furst...is different than the web browser of Furst" (para. 24, lines 7-8). First, it will be recalled that the "client" as defined by Furst has a web browser program embedded therein (col. 4, lines 63-65), and hence is not by any sense of the word "independent" from a web browser program. Second, and perhaps most revealing, is the fact that col. 8, lines 20-38, discusses positioning tool windows relative to a web browser window.

The Examiner further points to col. 8, lines 40-48, in support of the assertion that Furst may render its tools independent of a web browser program. However, as previously discussed, that section merely outlines the possible alternate shapes for tool windows ("including free-form graphics displayed without enclosing boxes or window decorations") and does not teach or suggest anything contrary to the many references in Furst to rendering tool windows with a web browser application.

Appl. No. 09/558,025

In fact, as Furst is replete with references to and illustrations of the dependence on a web browser, to render tool windows without a web browser applicant becomes a significant modification to the fundamental operating principles of the invention disclosed by Furst. As a matter of law, if such a significant modification is required to yield the claimed invention, then a finding of obviousness cannot be sustained. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.02.

The Examiner also suggests that applicant has not provided support for its "interpretation" of the phrase "rendered independently from a web browser program" (Office Action, para. 24, lines 18-19). However, it is not applicant's interpretation that is at issue. Rather, it is whether the Examiner has met the incumbent initial burden of proof (e.g., under Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990)) of demonstrating a *prima facie* case of obviousness. Applicant asserts that even assuming the everyday meaning of "independently", Furst clearly fails to teach rendering its tool windows "independently" of a web browser program, and thus no *prima facie* case of obviousness has been made.

Accordingly, applicant has demonstrated that the Furst patent does not teach or suggest:

Appl. No. 09/668,925

that "the frame and first Internet content [be] rendered independently from a Web browser program" (claim 31, lines 7-8, emphasis added)

"the user interface and content data presented independently from a Web browser program" (claim 50, lines 6-7, emphasis added)

"displaying independently from a Web browser program the user interface with which a visual manifestation of the content data is presented" (claim 62, lines 7-8, emphasis added)

"said frame further rendered independent of a Web browser program" (claim 70, lines 7-8, emphasis added), nor

"the frame and first Internet content rendered independently from a Web browser program" (claim 76, lines 9-10, emphasis added).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). As the limitation "rendered independently from a Web browser program" (and its variants, above) is not found in Furst, no *prima facie* case of obviousness has been established with regard to claims 31, 50, 62, 70 or 76.

Each of the remaining claims in the present application depends, directly or indirectly, on one of claims 31, 50, 62, 70 or 76, and therefore contains all limitations of

Appl. No. 09/568,925

the claim on which it depends. As the Furst reference fails to teach all elements of claims 31, 50, 62, 70 and 76 and thus fails to render those claims *prima facie* obvious, for the same reasons Furst also fails to teach all elements of the remaining dependent claims, and thus fails to render those claims *prima facie* obvious.

Based on this additional line of reasoning, applicant asserts that claims 31-77 are not rendered unpatentable under 35 U.S.C. §103(a) by Furst. Therefore, applicant respectfully requests that the rejection of claims 31-77 under 35 U.S.C. §103(a) in light of Furst be reversed and indicated as allowable.

MAR 05 2007

Appl. No. 09/558,925

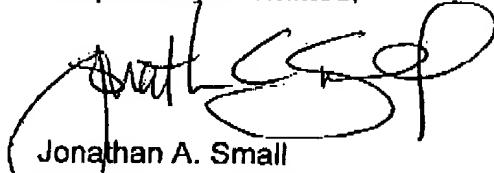
9. Summary and Conclusion

In summary, the applied reference fails to teach or suggest the concept covered in rejected claims 31-77 of rendering Internet content in a frame, having a format and controls which are specific to the Internet content, independently from a Web browser program and not confined by a window of a Web browser program. Based on the fact that there is at least one limitation in each rejected claim not found in the cited reference, and no cited suggestion can be derived from the reference or in the art in general to modify the reference to obtain the missing limitation, no *prima facie* case of obviousness under 35 U.S.C. §103(a) has been made.

Furthermore, claims 70-75 are drafted to a statutory class of invention. As such, they meet the formal requirements of 35 U.S.C. §101.

Accordingly, applicant requests that the Board reverse the rejections of all claims, with remand to pass this application to allowance.

Respectfully submitted,



Jonathan A. Small
Attorney for Applicant
Registration No. 32,631
Telephone: 650-941-4470

343 2nd Street, Suite F
Los Altos, CA 94022
Date: March 5, 2007

MAR 05 2007

Appl. No. 09/558,925

APPENDIX 1 – Appealed Claims

31. A method for presenting Internet content to a user of a computing device, comprising:

obtaining a first Internet content that is programmed in a format readable by a Web browser program; and

rendering the first Internet content in a frame having a format and controls which are specific to the first Internet content to produce a visual manifestation of the first Internet content on an output apparatus of the computing device, the frame and first Internet content rendered independently from a Web browser program, and wherein the visual manifestation of the first Internet content is not confined by a window of a Web browser program, and further wherein the first Internet content comprises at least a portion of a definition of the frame for the visual manifestation.

32. The method of claim 31, wherein the step of obtaining the first Internet content further comprises the step of obtaining the complete definition of the frame for the visual manifestation.

Appl. No. 09/558,925

33. The method of claim 31, further comprising:

obtaining a second Internet content that is programmed in a format readable by a Web browser program; and

rendering the second Internet content in a frame having a format and controls which are specific to the first Internet content to produce a visual manifestation of the second Internet content on the output apparatus of the computing device, the frame and first Internet content rendered independently from a Web browser program, and wherein the visual manifestation of the second Internet content is not confined by a window of a Web browser program.

34. The method of claim 33, wherein the step of obtaining the second Internet content further comprises the step of obtaining a definition of the frame for the visual manifestation of the second Internet content.

35. The method of claim 31, wherein the first Internet content comprises XML codes.

36. The method of claim 35, wherein the definition of the frame comprises XML tags.

Appl. No. 09/558,925

37. The method of claim 31, wherein the first Internet content comprises JavaScript codes.

38. The method of claim 37, wherein the definition of the frame comprises JavaScript tags.

39. The method of claim 31, wherein the rendering step comprises rendering the first Internet content to produce a visual manifestation of a calculator on an output apparatus of the computing device, wherein the visual manifestation of the calculator is not confined by a window of a Web browser program, and further wherein the first Internet content comprises a definition of a frame for the visual manifestation of the calculator.

40. The method of claim 31, wherein the rendering step comprises rendering the first Internet content to produce a visual manifestation of a media player on an output apparatus of the computing device, wherein the visual manifestation of the media player is not confined by a window of a Web browser program, and further wherein the first Internet content comprises a definition of a frame for the visual manifestation of the media player.

Appl. No. 09/658,925

41. The method of claim 31, wherein the rendering step comprises rendering the first Internet content to produce a visual manifestation of a means for accessing streaming media on an output apparatus of the computing device, wherein the visual manifestation of the means for accessing streaming media is not confined by a window of a Web browser program, and further wherein the first Internet content comprises a definition of a frame for the visual manifestation of the means for accessing streaming media.

50. A method for presenting Internet content to a user of a computing device, comprising:

obtaining data that is programmed in a format readable by a Web browser program, the data comprising content data and a definition that defines at least in part a user interface within which the content data is presented; and

presenting a manifestation of the content data to the user in the user interface, the user interface and content data presented independently from a Web browser program, wherein the manifestation is not confined by a window of a Web browser program.

52. The method of claim 50, wherein the definition defines at least in part a functionality available to the user to control presentation of the content data.

53. The method of claim 50, wherein the data is provided by a content developer.

Appl. No. 09/558,925

54. The method of claim 53, wherein the definition of the user interface and the functionality available to the user to control presentation of the content data is provided by the content developer.

55. The method of claim 50, wherein the content data is provided by a first entity, and wherein the definition of the user interface and the functionality available to the user to control presentation of the content data is defined by a second entity.

60. The method of claim 50, wherein the retrieving step comprises retrieving the data from the World Wide Web.

61. The method of claim 50, wherein said retrieving step comprises retrieving the data from a memory of the computing device.

62. A method for presenting Internet content to a user of a computing device, comprising:

obtaining data programmed in a format readable by a Web browser program;
determining that the data comprises content data and a definition that defines at least in part a user interface within which the content data is presented and at least in part a functionality available to a user to control presentation of the content data;
based on at least in part the definition, displaying independently from a Web browser program the user interface with which a visual manifestation of the content data

Appl. No. 09/558,925

is presented, wherein the user interface comprises a selectable option corresponding to the functionality available to the user, wherein the visual manifestation of the content data and the user interface is not confined by a window of a Web browser program; and in response to a user input selecting the selectable option, altering the visual manifestation of the content data.

63. The method of claim 62, wherein the data is provided by a content developer.
64. The method of claim 63, wherein the functionality available to the user to control presentation of the content data is defined by the content developer.
65. The method of claim 62, wherein the content data is provided by a first entity, and wherein the functionality available to the user to control presentation of the content data is defined by a second entity.
66. The method of claim 62, wherein the definition comprises JavaScript codes that define the user interface through which the manifestation of the content data is presented.
67. The method of claim 66, wherein the definition comprises JavaScript codes that define a play button configured to allow the user to playback the manifestation of the content data upon selection thereof.

Appl. No. 09/558,925

68. The method of claim 62, wherein said retrieving step comprises retrieving the data from the World Wide Web.

69. The method of claim 62, wherein said retrieving step comprises retrieving the data from a memory of the computing device.

70. A computer-readable storage medium having stored thereon a software object for displaying and interacting with content data in a frame independent of a Web browser program, comprising:

 a reference to the content data, the content data deliverable over the Internet and viewable within a window of a Web browser program; and

 a frame definition, specific to the content data, for rendering said frame, said frame including a visual manifestation of the content data, said frame further rendered independent of a Web browser program.

71. The computer-readable storage medium of claim 70, wherein said software object is stored on a first system, and further wherein said content data is stored on a second system separate from said first system.

Appl. No. 09/558,925

72. The computer-readable storage medium of claim 70, wherein said software object is stored on a first system, and further wherein said content data is provided to the software object at least in part from a processor associated with said first system.

73. The computer-readable storage medium of claim 70, wherein said software object is stored on a first system, and further wherein a portion of said frame definition includes a reference to code forming a part of a second software object, the second software object being stored on said first system.

74. The computer-readable storage medium of claim 73, wherein said frame definition further comprises a definition of controls permitting a user to interact with said visual manifestation of the content data.

75. The computer-readable storage medium of claim 74, wherein a portion of said definition of controls includes a reference to code forming a part of the second software object.

76. One or more processor readable storage devices having processor readable code embodied thereon, said processor readable code for programming one or more processors to perform a method of presenting and interacting with Internet content, the method comprising the steps of:

Appl. No. 09/558,026

obtaining a first Internet content that is programmed in a format readable by a Web browser program; and

rendering the first Internet content in a frame having a format and controls which are specific to the first Internet content to produce a visual manifestation of the first Internet content on an output device, the frame and first Internet content rendered independently from a Web browser program, and wherein the visual manifestation of the first Internet content is rendered separate from a window of a Web browser program.

77. The method of claim 76, wherein the step of obtaining the first Internet content further comprises the step of obtaining a definition of the frame for the visual manifestation.

RECEIVED
CENTRAL FAX CENTER

MAR 05 2007

Appl. No. 09/658,925

APPENDIX 2 – Evidence of Record

No additional evidence is being submitted with this appeal.

x

Appeal Brief

03/05/2007 11:06 6509414405

JAS IP CONSULTING

RECEIVED PAGE 41/41
CENTRAL FAX CENTER

MAR 05 2007

Appl. No. 09/658,925

APPENDIX 3 -- Related Proceedings

There are currently no proceedings related to this appeal.